



P A T E N T

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

David D. Cox et al.

Serial No. : 10/644,049

Examiner: I. Ghali

Filed : August 19, 2003

Group Art Unit: 1615

For : ANTIMICROBIAL CONTAINING SOLVENTLESS HOT
MELT ADHESIVE COMPOSITION

Docket No. : 16011/103/105

COMMUNICATION AND RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE UNDER 37 C.F.R. 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an enveloped addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 26th day of July, 2005.

By: _____

Carolyn I. Erickson

Sir:

Applicants are in receipt of a first Office Action with respect to the above-captioned continuation patent application matter. Eight claims were pending in the application (that is, Claims 22-29). The examiner acknowledged receipt of Applicants' Preliminary Amendment by which Claims 1-21 were cancelled and Claims 22-29 added. The examiner also acknowledged receipt of the drawings filed March 5, 2004.

In the Office Action, the examiner rejected Claims 22-29 under the judicially-created doctrine of obviousness-type double patenting. It was the examiner's opinion that those eight claims

were unpatentable over Claims 1-19 of United States Patent No. 5,829,442; Claims 1-21 of United States Patent No. 6,216,699; Claims 1-4 of United States Patent No. 6,503,531; and Claims 1-4 of United States Patent No. 6,607,746. The examiner indicated that, although the conflicting claims were not identical, they were not patentably distinct from each other because the claims of each of the issued patents and the present claims are all directed to a hot melt adhesive composition comprising an acrylic polymer and antimicrobial agent dispersed therein. The examiner indicated that the situation was one of anticipatory-type double patenting.

Claims 22-29 were further provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-16 of co-pending application Serial No. 10/717,380. The examiner indicated that the rejection was a provisional rejection because the conflicting claims have not, in fact, been patented.

Further, the examiner rejected Claims 22-29 under 35 U.S.C. § 112, first paragraph. It was the examiner's opinion that the specification, while being enabling for diiodomethyl-p-tolylsulfone as an antimicrobial agent dispersed in an acrylic polymer, it does not reasonably provide enablement for all antimicrobial agents. It was further the examiner's opinion that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with the present claims.

Finally, the examiner imposed a Restriction Requirement. Restriction to one of two inventions was required under 35 U.S.C. § 121. The examiner defined Group I claims, Claims 22-28, drawn to a hot melt adhesive for skin application, classified in Class 424, Subclass 448, and a Group II claim, Claim 29, drawn to a solventless adhesive composition, classified in Class 524, Subclass 204. The examiner advised Applicants that a reply to the

Restriction Requirement, to be complete, must include an election of the invention to be examined even though the requirement be traversed.

In response to the positions taken by the examiner, Applicants, first, elect to prosecute Claims 22-28 in this application. Claim 29, while defining a non-elected invention, has not been cancelled and is presently maintained in the case. In view of the election made, however, it is assumed that Claim 29 is withdrawn from consideration, and arguments for patentability made hereinafter address only Claims 22-28.

With respect to the double patenting rejection, Applicants hereby submit a Terminal Disclaimer with respect to each of four patents which issued on applications within a chain of which the present application is a part. No Terminal Disclaimer has been submitted with respect to co-pending Application Serial No. 10/717,380. That pending application has not yet matured into a patent and, therefore, at present, cannot be the basis for a presently efficacious double patenting rejection. It is submitted, in view of the taking of this action, that all bases for rejection of claims on the grounds of double patenting have been obviated.

Applicants hereby respectfully traverse the rejection of Claims 22-29 under 35 U.S.C. § 112. Claim 22 defines "a hot melt adhesive composition," "the composition as having antimicrobial properties," "the composition as being for skin contact applications," "the composition as comprising an acrylic polymer," and "the composition as comprising an effective amount of a heat stable antimicrobial agent dispersed throughout said acrylic polymer." It is submitted that this invention is supported in the specification and enabled thereby. Applicants would concede that diiodomethyl-p-tolylsulfone, as an antimicrobial agent dispersed in an acrylic polymer, is the best mode of practicing the invention. It is also clear, however, that the specification does not

foreclose other antimicrobial agents. This particular antimicrobial agent is one of a number of antimicrobial agents capable of functioning in the invention. The specification is replete with terminology characterizing this agent as "preferred" and discussed only by way of "example". It is submitted then that the particular antimicrobial agent disclosed and discussed is not exclusive. It can clearly be drawn from the language in the specification that other agents are appropriate and satisfy the terms of Claim 22.

That is not to say that the specific antimicrobial agent disclosed (that is, diiodomethyl-p-tolylsulfone) cannot serve as a basis, in itself, for patentability. While multiple agents are encompassed within the terms of Claim 22, it has been found that the best mode is in fact that - the best mode of practicing the invention.

In view of the action taken by this paper and the arguments offered in support of patentability, it is sincerely believed that this case is now in condition for allowance. Allowance of the application and passing of the file for issuance of formal allowance documents are, therefore, earnestly solicited.

Please charge any deficiencies or credit any over payment to Deposit Account 14-0620.

Respectfully submitted,

David D. Cox et al.

By their attorney

Date

July 26, 2005

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